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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/355,953	10/07/1999	JUNICHI HIKITA	P806-9020	7155

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EXAMINER

FISCHEITTI, JOSEPH A

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/355,953

Applicant(s)

HIKITA ET AL

Examiner

Joseph A. Fischetti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,9,11 and 12 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 3,9,11,12 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, and 9, 11, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi et al. in view of Shi et al. (PCT pub date 2/6/97) and Oruc et al.

Takahashi et al. teach: a first cryptogram the wired logic circuit (col. 2 lines 56-67); the second cryptogram portion is read as the verification value 150 (third embodiment), and point changing means being the command decoder 20. However, there is no disclosure of a resultant third value cryptogram generated from the first and second. However, Shi et al. does teach resetting a smart card wherein a new or third code is printed on an IC card following a comparison between its codes A and B, or i.e. the first and second cryptograms. But this third code is generated from a random pool and not a resultant of the first and second cryptogram values. Oruc et al. does however teach generating a third value based upon a resultant of first and second codes. It would be obvious to modify the device in Takahashi et al. to include a resultant third cryptogram as taught by Shi et al. which is the resultant of the two other cryptogram values as taught by Oruc et al. the motivation being that the card will be self authenticating.

Re claim 9: the processor IC1 in Shi et al. is read as the comparing means and the wherein clause is deemed to have insufficient structure and thus is functional.

Re claims 11 and 12: the converted codes A/B in Shi et al. are deemed to be equivalents to the generated ones as both have randomness involved.

The combining of references is motivated by the following. First, the command decoder 20/210 does in Takahashi et al. decode a read command, and it supplies a read signal and an address signal to the read/write control logic 110. It does not create a third resultant value. Col. 6 lines 28 et seq. shows a motivation for changing an encryption to "avoid dishonestly without restriction". It doesn't change encryption, but rather suggests rewriting a logic circuit to include a different code. This leaves open the need to generate some sort of new code to avoid dishonest use of the card in Takahashi et al. Shi et al answers this problem by randomly generating a third code which does not effect the first and second codes which does not force the user to learn a new code each time it is used, see col. 1, lines 27-30. The motivation is clear from Shi et al. to maintain the first and second cryptograms to avoid having the make the user change his cryptogram every time he uses it. The generation of the third value from the first and second ones is suggested by Takahashi et al. in that both keys must match col. 8 lines 45 et seq. before a new value is created. While Takahashi et al. teach erasing the codes to prevent dishonest use, Oruc et al. which teaches a resultant value from two given codes, would be an obvious modification to motivation would be again to allow the user to keep his code without having to change it as taught by Shi et al.

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The first portion is read as Takahashi et al. is read as the logic circuit col. 2, line 56, the second cryptogram is read as the verification value 150, the third portion is read as the decoder 20 /210 third embodiment.

RESPONSE TO ARGUMENTS:

Applicant's arguments filed 3/7/05 have been fully considered but they are not persuasive. Applicant first argues that "the cited prior art are non-analogous". Whether a reference in the prior art is "analogous" is a fact question. *Panduit Corp. v. Dennison Mfg.*, 810 F.2d 1561, 1568 n.9, 1 USPQ2d 1593, 1597 n.9 (Fed. Cir.), cert. denied, 481 U.S. 1052 (1987). One of the criteria have evolved for determining whether prior art is analogous is whether the art is from the same field of endeavor, regardless of the problem addressed. *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986); *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979). Field of endeavor of Takahashi et al. '701, Shi et al., and Oruc et al. are in the same field of endeavor namely, a memory device which use codes/decodes to effect use.

The combining of references is motivated by the following. First, the command decoder 20/210 does in Takahashi et al. decodes a read command, it supplies a read signal and its address signal to the read/write control logic 110. It does not create a third resultant value. Col. 6 lines 28 et seq. shows a motivation for changing an encryption to "avoid dishonestly without restriction". It doesn't change encryption, but rather suggests rewriting a logic circuit to include a different code.

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This leaves open the need to generate some sort of new code to avoid dishonest use of the card in Takahashi et al. Shi et al answers this problem by randomly generating a third code which does not effect the first and second codes which does not force the user to learn a new code each time it is used, see col. 1, lines 27-30. The motivation is clear from Shi et al. to maintain the first and second cryptograms to avoid having the make the user change his cryptogram every time he uses it. The generation of the third value from the first and second ones is suggested by Takahashi et al. in that both keys must match col. 8 lines 45 et seq. before a new value is created. While Takahashi et al. teach erasing the codes to prevent dishonest use, Oruc et al. which teaches a resultant value from two given codes, would be an obvious modification to motivation would be again to allow the user to keep his code without having to change it as taught by Shi et al.

The first portion is read as Takahashi et al. is read as the logic circuit col. 2, line 56, the second cryptogram is read as the verification value 150, the third portion is read as the decoder 20 /210 third embodiment.

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Joseph A. Fischetti at telephone number (703) 305-0731.

Joseph A. Fischetti
Primary Examiner
Art Unit 3627



JOSEPH A. FISCHETTI
PRIMARY EXAMINER